

REMARKS

Claims 1-19 are pending in the application. Claims 1, 7, 15, 17, and 18 have been amended. Claims 2 and 3 have been canceled and their subject matter incorporated into claim 1. Similar limitations have been incorporated into claims 15, 17, and 18. As these limitations have been previously considered, Applicant submits that the amendments do not require further search or consideration and should be entered.

Rejections under 35 U.S.C. § 112

The Office Action indicates that claims 7 and 10 stand rejected under 35 U.S.C. § 112, second paragraph, as being misdescriptive. Applicant respectfully traverses the rejection.

The Office action cites, as the definition of diverging, “to move or extend in different directions from a common point : draw apart.” Applicant submits that this definition applies to “diverging” as used in claim 7 and 10 because portions of the airflow are “drawing apart” as the air enters the diverging room from the conduit and as the air moves into the distributor. Applicant further submits that the term as used meets the standard imposed by MPEP § 2173.02, which focuses on “whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available.” Moreover, § 2173.02 requires that “[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.” Accordingly, as the term “diverging” is applicable to the claims as described above, Applicant respectfully requests that the rejection of claims 7 and 10 under 35 U.S.C. § 112 be withdrawn.

Objections to the Specification

The Office Action objects to the specification’s use of the term “diverging room.” Applicant respectfully traverses the objection for the same reasons stated in the previous section with respect to claims 7 and 10.

Rejections under 35 U.S.C. § 102 and § 103

Claims 1, 2, 4, 6-12, and 14-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,944,602 to Grundy (“Grundy”). Claims 3, 5, and 13 stand rejected under 35 U.S.C. § 103 as being obvious over Grundy or a combination of Grundy and U.S. Patent No. 4,100,847 to Norton (“Norton”) or U.S. Patent Pub. 2005/0017617 to Becke (“Becke”). As claim 3 has been incorporated into claim 1 and claim 3 was rejected based on the combination of Grundy and Norton, the following discussion addresses the rejection under U.S.C. § 103 based on the combination of Grundy and Norton. As claims 15, 17, and 18 also include a distributor as recited by claim 3, the following discussion applies equally to claims 15, 17, and 18. Applicant respectfully submits that the combination of Grundy and Norton is improper because the prior art does not suggest the desirability of the claimed invention and the combination is the result of impermissible hindsight reasoning.

As described in MPEP § 2143.01(I), “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’ *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

Grundy and Norton fail to contain any teaching, suggestion, or motivation of the proposed combination and modification, either explicitly or implicitly. The Office action recognizes this and relies on the statement that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the cabinet of Grundy with a plate having apertures there through, as taught by Norton in order to provide laminar flow.” (Office action, pages 2 and 3). However, Grundy describes a solution to this problem in the following manner at col. 7, lines 33-46, as follows:

Accordingly, to promote an even parallel flow distribution transversely across the cross sectional dimension of the cavity, an accumulation chamber 45 is provided between the upstream end 29 of cavity 23 and the opposed first openings 33, 33' of the air flow passages 32, 32'. Therefore, as the recirculating air passes through the air flow passages, it is discharged from the first openings into the accumulation chamber where the velocity of the recirculating air is dispelled. This discharged air accumulates in the accumulation chamber 45 to provide a "reservoir" of recirculated air at the entrance end 42 of the filter element 31. The pressure of the accumulated air just before the filter entrance end 42 is caused to be more evenly distributed transversely thereacross.

Both Fig. 3 and Fig. 7 provide for such an "accumulation chamber" in combination with a filter. Accordingly, one skilled in the art would have had no motivation to combine Grundy with Norton as suggested by the Office action, as Grundy had already provided for an accumulation chamber in combination with a filter to "promote an even parallel flow distribution." The Office action fails to explain why one skilled in the art would have been motivated to solve a problem that had been addressed in the primary reference, and to solve the problem in a different way than that provided by the primary reference.

Furthermore, Applicant submits that the Office action's reasoning as to motivation for the combination is a clear case of impermissible hindsight reasoning. The case law makes it clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *Dembiczak*, 50 USPQ2d, 1614, 1617 (Fed. Cir. 1999). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *Id.* Accordingly, it is respectfully submitted that the only way in which Grundy and Norton could be pieced together to defeat patentability is to use Applicant's disclosure as a blueprint.

Furthermore, as required by the courts, *particular findings* must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these

components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000). Applicant submits that the Office action provides no particular findings as to why one skilled in the art would take the teachings of Norton and combine them with Grundy in the manner required, particularly when Grundy had already provided a different solution to the problem from that provided in Norton.

Accordingly, Applicant submits that the combination of references is improper and that claims 1, 15, 17, and 18 are allowable over the cited combination. Claims 4-14, 16, and 19 depend from and further limit one of claims 1, 15, 17, and 18 and are allowable for at least the same reason as the claim from which they depend.

Conclusion

It is respectfully submitted that all pending claims in the application are in condition for allowance. Should the Examiner deem that any further amendment is needed to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Please grant any extension of time required to enter this response and charge any additional required fees to our Deposit Account No. 08-1394.

Respectfully submitted,

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